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04/22/91
DATE - MAILED

THE INFORMATION CONTAINED HEREIN IS UNCLASSIFIED
DATE 08/01/01 BY 60322 UCBAW/STP/MLK

☒ This application has been examined ☒ Responsive to communication filed on 8/30/90 ☐ This action is made final.

A shortened statutory period for response to this action is set to expire 3 month(s), 1 day from the date of this letter.
Failure to respond within the period for response will cause the application to become abandoned. 35 U.S.C. 133

Part I THE FOLLOWING ATTACHMENT(S) ARE PART OF THIS ACTION:

- | | |
|---|---|
| 1. <input checked="" type="checkbox"/> Notice of References Cited by Examiner, PTO-892. | 2. <input type="checkbox"/> Notice re Patent Drawing, PTO-948. |
| 3. <input type="checkbox"/> Notice of Art Cited by Applicant, PTO-1449. | 4. <input type="checkbox"/> Notice of Informal Patent Application, Form PTO-152 |
| 5. <input type="checkbox"/> Information on How to Effect Drawing Changes, PTO-1474. | 6. <input type="checkbox"/> |

Part II SUMMARY OF ACTION

1. ☒ Claims 17-21 and 23 are pending in the application.
Of the above, claims _____ are withdrawn from consideration.
2. ☒ Claims 1-16 and 22 have been cancelled.
3. ☐ Claims _____ are allowed.
4. ☒ Claims 17-21 and 23 are rejected.
5. ☐ Claims _____ are objected to.
6. ☐ Claims _____ are subject to restriction or election requirement.
7. ☐ This application has been filed with informal drawings under 37 C.F.R. 1.85 which are acceptable for examination purposes.
8. ☐ Formal drawings are required in response to this Office action.
9. ☐ The corrected or substitute drawings have been received on _____. Under 37 C.F.R. 1.84 these drawings are ☐ acceptable; ☐ not acceptable (see explanation or Notice re Patent Drawing, PTO-948).
10. ☐ The proposed additional or substitute sheet(s) of drawings, filed on _____, has (have) been ☐ approved by the examiner; ☐ disapproved by the examiner (see explanation).
11. ☐ The proposed drawing correction, filed _____, has been ☐ approved; ☐ disapproved (see explanation).
12. ☐ Acknowledgement is made of the claim for priority under U.S.C. 119. The certified copy has ☐ been received ☐ not been received ☐ been filed in parent application, serial no. _____; filed on _____.
13. ☐ Since this application appears to be in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under Ex parte Quayle, 1935 C.D. 11; 453 O.G. 213.
14. ☐ Other

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Claims 17-21 and 23 are rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 1-16 of U.S. Patent No. 5,004,863. Although the conflicting claims are not identical, they are not patentably distinct from each other because both sets of claims are drawn to genetically transformed cotton plants and seeds, wherein the process of making said plants and seeds does not appear to impart a unique characteristic to the plants and seeds.

The obviousness-type double patenting rejection is a judicially established doctrine based upon public policy and is primarily intended to prevent prolongation of the patent term by prohibiting claims in a second patent not patentably distinct from claims in a first patent. In re Vogel, 164 USPQ 619 (CCPA 1970). A timely filed terminal disclaimer in compliance with 37 C.F.R. § 1.321(b) would overcome an actual or provisional rejection on this ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 C.F.R. § 1.78(d).

Claims 17 and 20 are rejected under 35 U.S.C. § 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which applicant regards as the invention. Claim 17 is indefinite in its recitation of "cellular product . . . trait selected from the group consisting of a foreign protein and a negative strand RNA" as it is unclear whether the product or the trait is selected from the recited group. Claim 20 is indefinite in its recitation of "negative RNA strand" as it is unclear what Applicant intends. It appears that --negative strand RNA-- was intended, as recited in claims 17 and 23.

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Claim 19 is rejected under 35 U.S.C. § 112, fourth paragraph, as being of improper dependent form for failing to further limit the subject matter of a previous claim. Claim 19, drawn to cotton seeds containing an exogenous protein or an RNA which induces a somatic change, fails to further limit claim 17, drawn to cotton seeds containing an exogenous protein or an RNA which imbues the plant with a detectable trait.

Claims 17-21 and 23 are rejected under 35 U.S.C. § 112, first paragraph, as the disclosure is enabling only for claims limited to transformed cotton seeds and cotton plants obtained by the process of Agrobacterium-mediated transformation, as per pages 13-20 of the specification. See M.P.E.P. §§ 706.03(n) and 706.03(z). The specification only demonstrates the obtention of whole transformed cotton plants via Agrobacterium-mediated transformation. Given the lack of availability at the time the claimed invention was made of techniques for whole cotton plant regeneration from protoplasts, wherein said protoplasts would have been necessary for non-Agrobacterium-mediated transformation, undue experimentation would have been required by one of ordinary skill in the art to obtain whole transformed cotton plants obtained by non-exemplified methods.

Claims 17-21 and 23 are deemed free of the prior art, in view of the failure of the prior art to teach the regeneration of whole cotton plants from transformed tissue, and further in view of the unpredictability inherent in antibiotic resistance-

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mediated transformed plant selection as taught by Widholm, as discussed in parent application Serial No. 06/937,384, now allowed U.S. Patent No. 5,004,863.

No claim is allowed.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to David T. Fox whose telephone number is (703) 308-1120.

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is (703) 308-0196.



David T. Fox
Patent Examiner
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April 18, 1991